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TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

EXAMINER

NGUYEN, TAN D

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/813,636
Filing Date: March 21, 2001
Appellant(s): BORTON, GREGORY F.

Michael L. Drapkin
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 6/28/06 appealing from the Office action
mailed 3/13/06.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

The summary of claimed subject matter contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows:

1) Ground of Rejection II, 103 rejections of claims 1-6, 22, 7-12, 19-21, 23 and 24 over Calver, is withdrawn.

2) Ground of Rejection VI, 112, 2nd paragraph, rejections of claims 1-6, 22, 7-12, 19-21, 23 and 24, is withdrawn.

3) Ground of Objection I, claim 1 for introducing new matter, is withdrawn.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,799,286

MORGAN et al

8-1998

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. **Claims 1-6, 22-24, 7-12, 19-21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

In order for the claimed invention to be statutory subject matter, the claimed invention must fall within one of the four statutory classes of invention as set forth in § 101 (i.e. (1) a process, (2) machine (apparatus), (3) manufacture (article of manufacture), or (4) composition of matter).

In the present case, Method claim 1 is directed to a "method for activity-based modeling for an organization", which is not within one of the classes of invention set forth in § 101.

The "method for activity-based modeling for an organization" comprising the steps of:

(a) receiving a pluralities of task entries, wherein each task entry is comprised of defined types of future action which will generate a result;

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(b) receiving a pluralities of resource entries, wherein each resource entry is comprised of defined types of personnel, hardware, software, services, or combinations thereof which are presumed to be available in the future;

(c.) receiving mapping information that shows a relationship between each of the task entries and the plurality of resource entries, wherein each task entry is assigned a subset of the plurality of resources;

(d) processing the pluralities of task entries, the plurality of resource entries and the mapping information with a computer to formulate a business model; and

(e) generating a forward-looking report after the processing step and related to the business model”,

are merely a disembodied abstract idea and do not produce a (1) useful and (2) tangible, and (3) concrete result. The result of the instant invention is a business model being displayed on a report. The model might be considered “useful” in reporting a trend or other business performance parameter. However, § 101, 2nd test requires that the result be reproducible or repeatable to meet the tangible and concrete requirement. See In re Swartz, 232 F.3d 862, 864, 56 USPQ2d 1703, 1704 (Fed. Circuit 2000). In the instant case, it’s not clear whether the result of the model is predictable or repeatable because of:

(1) in the 1st step, the task entry is comprised of defined types of future action which will generate a result, this is not totally predictable since it deals with the future of things,

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(2) in the 2nd step, each resource entry ... which are presumed to be available in the future, this is also not predictable since the presumed parameters may not be available in the future, and

(3) the result of the processing step is not predictable or repeatable because it's not clear whether a single business model is formulated or there are many different business models created based on a plurality of entries which shows that the results (business models) are not concrete since many business models could be created. Furthermore, there is no citation or an example in the specification of how the business model of the claimed invention is carried out. The last step calls for generating a forward-looking report after the processing step and related to (having some features related to) the business model above and not clearly using a specific business model to generate a report. Therefore, it's not clear whether the result of the report is consistently concrete since it could produce more than one model or different models depending on the input parameters. Moreover, there is no physical transformation of anything to another state or thing using the formulated business model of the processing step above even though this is dispositive. Therefore, claims 1-6, 22, 7-12, 19-21 are thus drawn to the abstract idea of preparing an activity-based business model.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the 1st paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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4. Claims 1-6, 22-24, 7-12, 19-21 are rejected under 35 U.S.C. 112, 1st paragraph, as failing to comply with the enablement requirement.

The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It's not clear how the processing step is carried out using the entries, task and resource entries (claim 7), with mapping information (claims 1 and 19) to formulate a business model? No example of how a business-model is created/formulated for claim 7 (broadest) or 1 or 19 have been cited in the specification, especially pages 5-6, and this would make it difficult for a skilled artisan to make and use the invention. For example, in claim 7 (broadest), in the specification page 5, line 4 to line 30, and to page 8, line 30, it's not clear how an entry of a task, i.e. research or cold calls, and entry of a resource assigned to it, i.e. a system such as computer server, correlating the entries, and processing the entries with a computer before entry of any historical information for the organization, to formulate a business model and printing a forward-looking report using the model?

5. Claim 6 calls for "wherein the organization comprises at least 1 of a project (s)" which is vague and indefinite since it's well known to a skilled artisan that a project, a single or multiple activities/tasks, can not be called an organization, normally consists of people working in an entity such as company, store, team, etc.

Claim Objections

6. Dependent claims 2, 8-11 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous

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claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

It's not clear how claim 2 further limit the scope of claim 1 with calls for "doesn't require historical information from a general ledger" or dealt with cost or the scope of the claim which mapping the task entries, resource entries to formulate a business model and generating a forward-looking report. How does a step of "attributing overhead expenses to the organization as a whole" further limit the steps of claim 1 above? which steps or which elements?

Similarly, dep. claim 11 which calls for "an activity-based costing report" is vague and indefinite and does not further limit the scope of the claimed invention which calls for "without requiring historical information from a general ledger for the organization" or cost-related data/information.

As for dep. claims 8-10, it's not clear how these dependent claims further limit independent claim 7. How does a step of "processing an activity entry" or "system entry" or "determining a demand for the system entry for an activity volume" further limit the steps deal with "task entry" and "resource entry" and correlating the "task entry" to the "resource entry" to formulate a business model based on these two related entries alone? To add any additional entry, one has to correlate that additional entry to any existing entry before processing that additional entry and formulate a business model using the additional entry.

Dependent claims 23 (article) and 24 (system) are objected because they contain the language of independent method claim 1 in the body of the claims. Applicant is requested to rewrite claims 23 and 24 in their independent forms.

7. Claims 23 (article), 24 (system) are rejected under 35 U.S.C. 102(b) as being anticipated by MORGAN et al.

As for dependent claim 23 (dependent of claim 1), which deals with a computer-readable medium having computer executable instructions for performing the computer implementable method for activity-based business modeling of claim 1 below, this is rejected over the computer-readable medium of MORGAN et al with executable instructions to carry out the method as shown in Figs. 1, 2. Note that the phrase "for performing the computer-implemented method for activity-based business modeling, this carries little patentable since it's non-functional data. Moreover, the medium does not connect to a computer and ordering / instructing the computer to carry out the steps. As for the negative limitation of "that does not require historical information from a general ledger" in the preamble, this carries little patentable weight since it does not appear in the body of the claim. Moreover, the use of the historical information from a general ledger in the modeling process is considered as option as shown on col. 3, lines 55-60 "may include" the general ledger for the benefit of making the result more realistic, reliable or accurate if desired but not necessary {see col. 1, lines 37-41, 50-55 or c3:55-60, c4:25-42}. Therefore, the computer-readable medium of MORGAN et al reads over the computer-readable medium of claim 23.

As for dependent claim 24, which deals with a computer system adapted to perform computer implementable method of claim 1 below, this is rejected over the computer system of Fig. 1 or 2. Note that in an apparatus claim, only structural elements receive patentable weight. Intended use of the computer system has no patentable weight. As for the negative limitation of "that does not require historical information from a general ledger" in the preamble, this carries little patentable weight since it does not appear in the body of the claim. Moreover, the use of the historical information from a general ledger in the modeling process is considered as option as shown on col. 3, lines 55-60 "may include" the general ledger for the benefit of making the result more realistic, reliable or accurate if desired but not necessary {see col. 1, lines 37-41, 50-55 or c3:55-60, c4:25-42}. Therefore, the computer system of MORGAN et al reads over the computer system of claim 24.

8. Claims 7-12, 1-6, 22, 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over MORGAN et al (US patent 5,799,286).

Independent method claim 7 (broadest) is as followed:

7. (Previously Presented) A method for activity-based business modeling for an organization without requiring historical information from a general ledger for the organization, the method comprising steps of:

- receiving a task entry and a resource entry wherein:
 - the task entry comprises a defined type of future action which will generate a result; and
 - the resource entry comprises a defined type of personnel, hardware,

software, services, or combination thereof which is presumed to be available in the future;

- correlating the task entry to the resource entry;
- processing the resource entry and the task entry with a computer before entry of any historical information for the organization, wherein a business model for the organization is formulated;
- generating a forward-looking report using the business model.

Similarly, **MORGAN et al** discloses a method for activity based business modeling for an organization, the method comprising the steps of:

- receiving a task (activity/ies performed to achieve business objective) entry and a resource entry wherein:

the task (activity/activities) entry comprises a defined type of future action which will generate a result {see col. 3, line 64 to col. 4, lines 1-5, 15-27, especially col. 5, lines 23-30 "activities 92 performed to achieve business objective, ... soliciting invention ..., drafting application", Fig. 5 (92) "ACTIVITY #1001 \$10" (96), Fig. 7 (116)};

the resource entry which is presumed to be available in the future {see Fig. 5, (92) "ACTIVITY #1001", (96) "\$10", Fig. 7, (114) "PEOPLE", (126), , col. 5, lines 45-47 "... dollars or resources are allocated"};

- correlating (mapping) the task (activity) entry to the resource (dollars) entry {see col. 5, lines 42-55, lines 65-67, col. 6, lines 1-45};

- processing the resource entry and the task entry with a computer before entry of any historical information for the organization, wherein a business model for the organization is formulated {see Fig. 5, 6, Fig. 7 (114), (116), (126), 12}; and
- generating a forward-looking (trend or forecast) report using the business model {see col. 4, lines 5-10 "*reports ... include trend, forecast...*"}

Note that the phrases "comprises a defined type of future action which will generate a result" on the "task entry" is non-functional descriptive material and receives no patentable weight. Moreover, the task entry of MORGAN et al, as shown on col. 5, lines 24-30, i.e. "soliciting invention disclosures, draft patent application, etc." inherently has this limitation. Similarly, the phrases "which is presumed to be available in the future" on the "resource entry" is non-functional descriptive material and receives no patentable weight. Moreover, the resource entry of MORGAN et al, as shown on col. 5, lines 40-47, i.e. "dollars or resources are allocated to the management organizations 82-86, for which activities have been identified", inherently has this limitation.

As for the negative limitation of "that does not require historical information from a general ledger" in the preamble, this carries little patentable weight since it does not appear in the body of the claim. Moreover, as shown MORGAN et al c1:37-41, 50-55 or c3:55-60, c4:25-42, the use of the historical information from a general ledger in the modeling process is for the purpose of making result more realistic, reliable or accurate since there is cost/cost basis associated with the activities involved. Note also on c3:55-60 which teaches the option of "may include" general ledger for the benefit above

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if desired but not necessary. Therefore, it would have been obvious to avoid the use of the historical information from a general ledger in the modeling process if making result more realistic, reliable or accurate or associated with cost is not critical or important as compared to other criteria such as speed, etc., or if the general ledger (GL) data is not available. Furthermore, elimination or removal of an element or step for its intended function in a method is well known practice and would have been obvious to an artisan, absent evidence of unexpected results. See *In re Karlson*, 136 USPQ 184, 186. Note also, on col. 7, lines 65-67, MORGAN et al discloses the input of "data entry 114 reflects the anticipated change", which indicates data reflecting future conditions or future task entries the respective resource entries.

Note on col. 5, lines 45-47, MORGAN et al discloses money/dollars as part of resources, "*the dollars or resources*" and are entered along with each activity as shown on Fig 5 (92), (96). Therefore, the use of other well known types of business resources besides money, i.e. personnel or equipment (hardware) would have been obvious to a skilled artisan as merely using other well known business resources and these are also taught on Fig. 7 (114) "*PEOPLE*", (118) "*EQUIPMENT*" or col. 4, lines 1-5.

As for dep. claim 8 (part of I), which deals with well known organization input parameters, i.e. activity entry or task entry, this is fairly taught in c4:1-4.

As for dep. claim 9 (part of I), which deals with well known organization input parameters, i.e. system entry, this is fairly taught in c4:1-4 or c4:22-24.

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As for dep. claim 10 (part of 7), which deals additional limitation of “determining a demand” for a specific entry such as system, this is inherently included c4:1-10 wherein a forecast or trend report is determined.

As for dep. claim 11 (part of 7), which deals immaterial modification, type of forecast report, this is inherently included c4:1-10 “value-added report” or would have been obvious to a skilled artisan as mere selection other similar type of report for intended purpose.

As for dep. claim 12 (part of 7), which has similar limitation as in dep. claim 4 above, it's rejected for the same reason set forth in claim 4 above.

Independent method claim 1 is as followed:

1. (Previously Presented) A method for activity-based business modeling for an organization that doesn't require historical information from a general ledger, the method comprising steps of:

- receiving a plurality of task entries, wherein each task entry is comprised of defined types of future action which will generate a result;
- receiving a plurality of resource entries, wherein each resource entry is comprised of defined types of personnel, hardware, software, services, or combinations thereof which are presumed to be available in the future;
- receiving mapping information that shows a relationship between each of the task entries and the plurality of resource entries, wherein each task entry is assigned a subset of the plurality of resources;

- processing the plurality of task entries, the plurality of resource entries and the mapping information with a computer to formulate a business model; and
- generating a forward-looking report after the processing step and related to the business model.

Similarly, **MORGAN et al** discloses a method for activity based business modeling for an organization, the method comprising the steps of:

- receiving a plurality of task (activities performed to achieve business objective) entries, wherein each task entry (activity) is comprised of future action which will generate a result {see col. 3, line 64 to col. 4, lines 1-5, 15-27, especially col. 5, lines 23-30 "activities 92 performed to achieve business objective, ... soliciting invention ..., drafting application", Fig. 5 (92) "ACTIVITY #1001 \$10" (96), Fig. 7 (116)};
- receiving a plurality of resource entries, wherein each resource entry comprises a defined type of personnel which is presumed to be available in the future {see Fig. 5, (92) "ACTIVITY.#1001", (96) "\$10", Fig. 7, (114) "PEOPLE", (126), , col. 5, lines 45-47 "... dollars or resources are allocated"};
- receiving mapping information that shows a relationship between each of the task entries and the plurality of resource entries, wherein each task entry is assigned a subset of the plurality of resources {see col. 6, lines 38-42, Fig. 7, (114), (116), (126)}.

- processing the plurality of task entries, the plurality of resources entries and the mapping information with a computer to formulate a business model {see Fig. 5, 6, Fig. 7 (114), (116), (126), 12}; and
- generating a forward-looking (trend or forecast) after the processing step and related to the business model {see col. 4, lines 5-10 "*reports ... include trend, forecast...*"}

Note that the phrases "comprises a defined type of future action which will generate a result" on the "task entry" is non-functional descriptive material and receives no patentable weight. Moreover, the task entry of MORGAN et al, as shown on col. 5, lines 24-30, i.e. "soliciting invention disclosures, draft patent application, etc." inherently has this limitation. Similarly, the phrases "which is presumed to be available in the future" on the "resource entry" is non-functional descriptive material and receives no patentable weight. Moreover, the resource entry of MORGAN et al, as shown on col. 5, lines 40-47, i.e. "dollars or resources are allocated to the management organizations 82-86, for which activities have been identified", inherently has this limitation.

As for the negative limitation of "that does not require historical information from a general ledger" in the preamble, this carries little patentable weight since it does not appear in the body of the claim. Moreover, as shown MORGAN et al c1:37-41, 50-55 or c3:55-60, c4:25-42, the use of the historical information from a general ledger in the modeling process is for the purpose of making result more realistic, reliable or accurate since there is cost/cost basis associated with the activities involved. Note also on c3:55-60 which teaches the option of "may include" general ledger for the benefit above

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if desired but not necessary. Therefore, it would have been obvious to avoid the use of the historical information from a general ledger in the modeling process if making result more realistic, reliable or accurate or associated with cost is not critical or important as compared to other criteria such as speed, etc., or if the general ledger (GL) data is not available. Furthermore, elimination or removal of an element or step for its intended function in a method is well known practice and would have been obvious to an artisan, absent evidence of unexpected results. See *In re Karlson*, 136 USPQ 184, 186. Note also, on col. 7, lines 65-67, MORGAN et al discloses the input of "data entry 114 reflects the anticipated change", which indicates data reflecting future conditions or future task entries the respective resource entries.

Note on col. 5, lines 45-47, MORGAN et al discloses cost or dollars as part of resources, "*the dollars or resources*" and are entered along with each activity as shown on Fig 5 (92), (96). Therefore, the use of other well known types of business resources, such as personnel or equipment (hardware) would have been obvious to a skilled artisan as fairly taught in MORGAN et al on Fig. 7 or col. 4, lines 1-5.

As for dep. claim 2 (part of 1), which deals with well known organization cost/expense parameter, i.e. overhead, this is fairly taught in Fig. 1 (26) or Fig. 16 (280).

As for dep. claim 3 (part of 1), which deals with well known organization resource parameters, i.e. a system or apparatus, this is fairly taught in Fig. 1 (22) or c4:1-4 (equipment).

As for dep. claim 4 (part of 1), which deals with a source of data entry for an entry above, i.e. from a template, this is non-essential to the scope of the claimed

invention and is fairly shown in Fig. 18B. Alternatively, the use of other similar modules (Fig. 1, 18) containing template format would have been obvious as mere using other module format to achieve similar results. As for the limitation “not produced by an end user”, this is inherently included in the teachings of MORGAN et al. Moreover, this carries little patentable weight since it’s a negative limitation and in a passive state.

As for dep. claim 5 (part of 1), which deals with similar limitation as in dep. claim 4 above, it’s rejected for the same reason set forth in dep. claim 4 above.

As for dep. claim 6 (part of 1), which deals with well known organization type parameter, i.e. department or whole company, this is fairly taught in c1:56, or c2:40-57.

As for dep. claim 22 (part of 1), which deals with well known task information parameters or type of task information, i.e. projected volume/quantity and duration, this is non-essential to the scope of the claimed invention and is fairly taught in c3:66 – c4:11, c17:50-55 “*product volumes ... for any number of months*”, c18:30-35.

As for independent method³ claim 19, which has similar limitation as in independent method claims 1, 3, 5 (combining receiving steps (a) and (b) into 1 step), it’s rejected for the same reason set forth in claim 1 above.

As for dep. claims 20-21 (part of 7), which have similar limitations as in dep. claims 5-6 (part of 1) respectively above, they are rejected for the same reason set forth in claims 5-6 above.

(10) Response to Argument

1) Applicant’s request for a clearer explanation of the 35 U.S.C.101 rejection is shown on paragraph 2 above. The insertion of the term “with a computer” on the

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4th step is insufficient to overcome the rejections. Applicant's comment that the independent claims 1, 7 and 19 produce a useful result, i.e. "generating a forward-looking report" is noted, however, as shown in the rejections above, the result of the processing step is not predictable or repeatable because it's not clear whether a single business model is formulated or there are many different business models created based on a plurality of entries which shows that the results (business models) are not concrete since many business models could be created. Furthermore, there is no citation or an example in the specification of how the business model of the claimed invention is carried out. The last step calls for generating a forward-looking report after the processing step and related to (having some features related to) the business model above and not clearly using a specific business model to generate a report. Therefore, it's not clear whether the result of the report is consistently concrete since it could produce more than one model or different models depending on the input parameters.

2) Applicant's comment that Morgan fails to teach the task and resource entries and mapping the relationship of the entries as shown in claim 7 (broadest) or claim 1 are noted, however, these are not found persuasive in view of the rejections cited above.

3) Applicant's comment that Morgan teaches a "backward facing" activity based management system and not "future action" as in the claimed invention is not persuasive because the limit "future action" reads over "forecasting" or

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“trend”, etc., as taught by Morgan on col. 4, lines 5-10, c19:52-67. Moreover, the use of “historical data” with respect to cost (from a general ledger) for forecasting is for producing a realistic, operational, and meaningful view of how the money was spent {see col. 4, lines 25-28}; however, as mentioned above, if producing a realistic, operational, and meaningful view of how the money was spent is not critical or the if historical data (general ledger) is not available, then it would have been obvious to bypass it (the usage of historical financial data) if desired. Note that on col. 7, lines 56-67, col. 8, lines 1-11, MORGAN et al discloses the use of 2nd type of data, estimated data and data entry reflecting anticipated change, which read over the limitations of the task entries of claim 1 above.

4) Applicant’s comment with respect to the objections of the dependent claims are not persuasive, for example, it’s not clear how dep. claim 2 further limits and fits in the steps and elements of claim 1 above since claim 1 requires mapping relationship between the received entries, i.e. task entries and resource entries and then processing these correlated variables to formulate a business model. It’s not clear how other entries or variables fit into the model without indicating a step of mapping their relationships with each other so that the processing step to create a business model can be carried out? It appears that the mapping of the relationship of the entries are critical before a model can be established. Therefore, adding entries or limitations without indicating how they are related are vague and indefinite and do not limit the initial business model based on the task entries and resources entries.

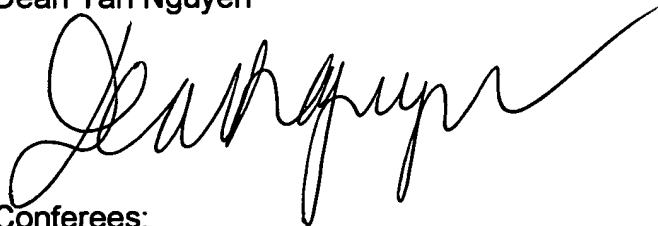
(11) Related Proceeding(s) Appendix: None.

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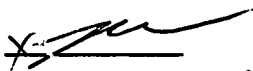
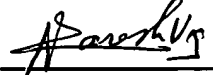
For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Dean Tan Nguyen



Conferees:

- 1) SPE: John Weiss,  date 9/14/06
- 2) Primary Examiner: Naresh Vig, , date 9/14/2006